

Remarks

The present Amendment is responsive to the Office Action of September 6, 2005. Reexamination and reconsideration of claims 1-10, 12-19 and 21-23 is respectfully requested.

Summary of The Office Action

Claims 12-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U.S. Patent 6,115,739 to Ogawa et al and U.S. Patent 6,426,806 to Melen.

Claims 1-10 and 21-23 were rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U.S. Patent 6,115,739 to Ogawa and U.S. Patent 6,825,942 to Kamiyama et al. in view of U.S. Patent 6,426,806 to Melen.

Claim 10 was rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,115,739 to Ogawa.

Response

In the Office Action on page 2, section 5, the Examiner submits that “where the processing for storing and routing the image data is irrelevant to the operation of the present invention.” Applicant points out that the present claims are directed to a scanning device that includes specific components that are configured in a specific way to perform specific functions as recited in the claims. The phrase “being part of the scanning device” is a limitation and is relevant. All limitations in a claim are relevant.

This phrase was inserted to avoid further misinterpretations of the claims. For example, claim 1 is a system that is a scanning device configured in the recited manner to perform the recited functions. Therefore, the Examiner must show art that teaches or makes obvious each and every element in the claims. If the present rejections are founded on limitations being irrelevant as it appears, then the present rejections are defective and do not comply with the requirements of 35 U.S.C. §103.

Additionally, on page 3 of the Office Action, the Examiner takes the position that since a scanner has a processor, then it is inherently obvious to enable the scanner to perform any function, such as to enable the scanner in Ogawa to perform the claimed functions. This position has no basis in patent law. MPEP §2143.01 (III) clearly states:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

It is well known that processors are configurable to perform functions and can be modified. However, under the Examiner's position, all computer-implemented inventions or electronic devices with processor-implemented inventions are obvious simply because they are configurable. This is clearly false. A claim is obvious only when appropriate prior art is presented that teaches or makes obvious each and every claimed limitation, and this includes the limitations of how a processor is configured.

The Examiner additionally states that the Applicant cited "the administrative software in Ogawa for proof that Ogawa's scanner device does not contain firmware." (Office Action, page 3, line 5-6). First, Applicant never presented such an argument. Second, the issue here is not whether Ogawa teaches firmware. Most scanners have firmware. The issue is whether Ogawa teaches a scanning device that includes firmware configured in the manner recited by the present claims and configured to operate with the other claimed elements as recited. Ogawa and Melen fail to teach or suggest the claimed scanning device configured with the claimed limitations, and it appears that the Examiner is ignoring some claimed limitations by saying they are "irrelevant" in order to compensate for deficiencies in the references. For at least this reason, the present rejections are improper under 35 U.S.C. §103 and should be withdrawn.

35 U.S.C. §103

To establish a prima facie case of 35 U.S.C. §103 obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP 2143.01 Second, there must be a reasonable expectation of success. MPEP 2143.02 Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.03 Additionally, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). This requirement is intended to prevent unacceptable "hindsight reconstruction" where Applicant's invention is recreated from references using the Application as a blueprint.

Here, the first, second, and third criteria described in MPEP §2143 are not satisfied since (1) there is no suggestion or motivation to modify or combine the references, (2) there is no reasonable expectation of success, and (3) the combination of references does not teach or suggest all the claim limitations.

Concerning the first criteria, no suggestion or motivation to modify or combine the references is given. For each §103 rejection, the Office Action makes a summary statement like that found on page 5, which states that because Melen has a processor "that can reside either within the scanner 106 or outside the scanner 106", then:

It would have obvious to one of ordinary skill in the art at the time of the invention to use a scanner or the processor residing in the scanner as taught by Melen to perform the functions disclosed by Ogawa.

This summary sentence falls well below the standard required for identifying the motivation to modify or combine. An obviousness rejection must be supported by reasons why one of ordinary skill in the art would have been motivated to select the references and combine them. See, e.g., *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2D 1453, 1459 (Fed. Cir. 1998). To follow the reasoning of a person of ordinary skill in the art, the skill level of that person must be ascertained and reported on. That is why the MPEP requires that the Office Action ascertain and describe the level of ordinary skill, so that objectivity can be maintained. MPEP §2141.03 reads:

The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry. *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). The examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand. *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984).

The present Office Action neither ascertains nor reports on the level of ordinary skill in the art, which is an additional failing associated with criteria one.

Concerning criteria two, no evidence has been presented to show any expectation of success from making the modifications proposed by the Office Action. The only basis presented is that a CPU can be enabled to transport data. As stated previously, just because a CPU can be modified does not make it obvious to modify. Furthermore, the present claims recite different limitations than a modifiable CPU, and no evidence has been presented as to why Ogawa's processor would be modified with new features, or how the processor would interact with other components to implement the new features, or why the other components would be modified to function with the new features. Thus, the second criteria is not met.

Concerning criteria three, none of the references, alone and/or in combination, teach or suggest all the claim limitations as will be described in more detail below. For at least these reasons, all the obviousness rejections are improper and should be withdrawn.

Each claim will now be examined to address the specific rejections provided in the Office Action:

I. §103(a) Rejection of Claims 12-20

Independent Claim 12

Claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Ogawa and Melen. The Office Action on page 4 states that Ogawa discloses the limitation of "obtaining, by the scanning device, user information..." and cites column 2, lines 30-35 of Ogawa. This section discloses inputting identification information on a user such as a user ID and correspondence between the

information and directories. At best, Ogawa's directories may be interpreted as the claimed imaging data store, but Ogawa fails to teach or suggest obtaining information of "a composition store associated to the user" as recited in claim 12. Therefore, Ogawa fails to teach or suggest this claimed feature and fails to support the rejection.

The Office Action goes on to state that the claimed "transferring, by the scanning device, the scanned imaging data to the imaging data store" is disclosed by Ogawa in column 2, lines 34-40. This is incorrect because Ogawa discloses "...said file server stores the image data in a directory..." (see column 2, lines 39-40). Therefore, this claimed limitation is not taught or suggested by Ogawa and the rejection is further not supported.

The Office Action then states that the claimed "storing by the scanning device, in the composition store associated to the user, a link reference that identifies a location of the scanned imaging data where the composition store maintains a plurality of link references to a plurality of imaging data that may be stored in separate imaging data stores" is disclosed by column 2, lines 34-42 and Figure 1. The Examiner interprets the user IDs of Ogawa as the claimed link references. User IDs are well known in the art and link references are well known in the art. One of ordinary skill in the art would not equate a user ID with a link reference and Ogawa provides no suggestion or motivation to believe otherwise. Furthermore, the Examiner's interpretation is not consistent with the present specification or the claims. Therefore, the Examiner's interpretation is not supported by the teachings of the art. For at least this reason, Ogawa fails to teach or suggest the "storing" limitation of claim 12.

Additionally, if user IDs are interpreted as link references (which they cannot be), Ogawa still fails to teach a scanner configured to store user IDs in a composition store. Rather, Ogawa discloses that each user stores their own ID in the directory associative file (see column 4, lines 46-49: "Each user of the image scanner registers his/her own ID information in a directory associative file shown in FIG. 4 in advance"). Therefore, the claimed limitation of storing by the scanning device is not taught or suggested by Ogawa. For this additional reason, Ogawa fails to teach or suggest the "storing" limitation of claim 12.

Regarding the Melen reference, the Office Action uses Melen for its teaching that a CPU can reside within the scanner and that it would be obvious to have the CPU of Melen perform the functions disclosed by Ogawa. Since Ogawa fails to teach or suggest each and every claimed step or function recited in claim 12 as explained above, using the CPU of Melen does not cure the shortcomings of Ogawa.

Therefore, Ogawa combined with Melen fails to teach or suggest present claim 12. Claim 12 is thus in condition for allowance. Accordingly, dependent claims 13-19 also patentably distinguish over the combined references and are in condition for allowance.

Independent Claim 20

Claim 20 was rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ogawa and Melen. Applicant respectfully submits that claim 20 was previously canceled and the present Office Action acknowledges the cancellation on page 2, paragraph 3. Therefore, the Examiner's rejection of claim 20 and its accompanying analysis on pages 8-9 are moot.

II. §103(a) Rejection of Claims 1-10 and 21-23

Independent Claim 1

Claim 1 was rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ogawa and Kamiyama et al. in view of Melen.

On page 10 of the present Office Action, it states that Ogawa discloses the claimed scanning device configured to obtain user information relating to a personal imaging repository...that is to be access by remote web services and cites column 2, lines 31-37. This section of Ogawa discloses a file server that stores image data in user directories. However, there is no discussion about images being accessed by remote web services and there is no suggestion of such a feature. One of ordinary skill in the art would understand that user directories are typically protected and secured from being accessed by remote web services. Thus without a proper suggestion of why Ogawa would do this, one of ordinary skill would assume that the

intent of Ogawa is to keep its user directories private and not to allow access from remote web services. Therefore, this limitation is not taught or suggested by Ogawa and the rejection is not supported.

Regarding the claimed element of a device firmware being part of the scanning device and being configured to store a link reference in a centralized data store, the Office Action states that Ogawa teaches this element at column 2, lines 39-42. As previously stated, this section of Ogawa teaches "...said file server stores the image data in a directory..." (see column 2, lines 39-40). Thus, the claimed firmware of the scanning device configured to operate in the claimed manner is not taught or suggested by Ogawa and the rejection is further not supported.

Here, as with claim 12, the Office Action interprets Ogawa's user ID as the claimed link reference. For the reasons set forth previously, the user ID is not a link reference, and furthermore, neither the scanner of Ogawa nor the file server store user IDs. Rather, Ogawa discloses that each user stores their own ID in the directory associative file (see column 4, lines 46-49, which states: "Each user of the image scanner registers his/her own ID information in a directory associative file shown in FIG. 4 in advance"). Therefore, the claimed limitation of a device firmware of the scanning device being configured to store link references as claimed is not taught or suggested by Ogawa. For this additional reason, Ogawa fails to teach or suggest the claim 1.

Regarding the limitation of "said personal imaging repository is an exchange infrastructure...", the Office Action cites Kamiyama to cure the shortcomings of Ogawa. Kamiyama discloses "...a system structure of an office network to which a network scanner system according to the present invention is applied." (column 3, lines 34-36). There is no mention of the Internet or the web, and no mention of allowing remote web services to access its data. Thus, the cited section of column 2, lines 33-64 fails to teach or suggest a repository where web services can access the repository. As such, Kamiyama fails to teach or suggest "an exchange infrastructure between the imaging data and the remote web services on the Internet" as recited in claim 1.

Furthermore, Kamiyama fails to teach or suggest “allowing the remote web services to locate imaging data associated with the particular user by accessing the centralized data store” as recited in claim 1. Kamiyama fails to mention any feature relating to locating image data from web services by accessing a centralized data store, which stores link references to the image data as claimed in claim 1. Therefore, Kamiyama fails to cure the shortcomings of Ogawa and the rejection is not supported for this additional reason.

Regarding the Melen reference, the Office Action combines the processor of Melen with Ogawa to perform the functions disclosed by Ogawa. Since Ogawa fails to teach or suggest all the claimed features of the claim 1, using the processor of Melen fails to cure Ogawa’s shortcomings. For this additional reason, the present rejection is not supported by the combination of Ogawa, Kamiyama, and Melen, and thus should be withdrawn.

Since claim 1 recites features not taught or suggested by the references, individually or in combination, claim 1 patentably distinguishes over the references. Accordingly, dependent claims 13-19 also patentably distinguish over the combined references and are in condition for allowance.

Independent Claim 21

The Office Action applies the same reasoning here with regard to the “transfer a link to a composition store...” limitation as applied for claim 1. It has been previously shown that Ogawa fails to teach or suggest a scanning device that is configured to store or transfer links to a composition store. Furthermore, neither Kamiyama nor Melen cure this shortcoming. Therefore, the combined references fail to teach or suggest all limitations of claim 21. Claim 21 thus patentably distinguishes over the references and is in condition for allowance.

Independent Claim 22

Claim 22 recites a computer program product that when executed causes a scanning device to perform a method comprising receiving references including a data store reference and a composition store reference. The Office Action on page 16 cites column 2, lines 34-42 of Ogawa for teaching this limitation and states that the

personal imaging repository is the directory in which images are stored and the composition store is where the user ID is stored and the link is the user ID. Even if the Examiner's interpretation is reasonable, it still fails to teach the claimed limitation.

For example, the scanner in Ogawa receives a user ID. However, a data store reference that identifies an imaging data store is not inputted to the scanner and further, a composition store reference (where the user ID is stored) is not inputted to the scanner. The user directories are created "in advance in one-to-one correspondence to users" (column 2, lines 33-34). Furthermore, the directory where the user ID is stored is predetermined and fixed by the administrative software of Ogawa. See column 4, lines 34-36, which states "A file for associating the data items with the directories is created in a designated directory by the administration software." Therefore, the scanner in Ogawa only receives a user ID and does not receive either the claimed references. Thus, the "receiving references" limitation of claim 22 is not taught or suggested by Ogawa.

Surely, the user ID in Ogawa cannot be used to teach all three claimed elements of a data store reference, a composition store reference, and link references that are links to the scanned image data. Ogawa thus fails to teach or suggest the claim 22.

The Office Action goes on to state that the claimed "transferring the scanned imaging data to the imaging data store" is disclosed by Ogawa in column 2, lines 34-40. This is incorrect because Ogawa discloses "...said file server stores the image data in a directory..." (see column 2, lines 39-40). Therefore, this claimed limitation of readable program codes that cause a scanning device to perform the claimed transferring is not taught or suggested by Ogawa and the rejection is further not supported.

Regarding the claimed limitation of "causing the link reference to be stored in a composition store...", Ogawa does not teach storing link references by a scanning device. Indeed, the locations of the image data are pre-designated by the user directories. The scanner in Ogawa has no need to store such references since the locations are already known. The Office Action (on page 17) attempts to cure this

shortcoming by combining the teachings of Kamiyama and makes reference to “an exchange infrastructure”. Applicant respectfully points out that an exchange infrastructure limitation is not recited claim 22 and has no relation to the claimed program code in a scanning device for causing link references to be stored in a composition store. Therefore, Kamiyama fails to cure the shortcomings of Ogawa.

Since claim 22 recites features not taught or suggested by the references, individually or in combination, claim 22 patentably distinguishes over the references. Accordingly, dependent claim 23 also patentably distinguish over the combined references and is in condition for allowance.

III. §103(a) Rejection of Claim 10

Claim 10 was rejection based on Ogawa. Claim 10 is dependent on claim 1. Since claim 1 has been shown to be patentable of the references of record, claim 10 also patentably distinguishes over the references of record. Claim 10 is thus in condition for allowance.

Hindsight Reconstruction

Concerning hindsight reconstruction, MPEP §2143 reads:

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant will now comment on the propriety of combining the Ogawa, Kamiyama, and Melen references in the manner performed in the Office Action. This appears to be hindsight reconstruction where the Office Action is using the Application as a blueprint to find parts of the claimed invention in unrelated references. Hindsight reconstruction has long been frowned upon:

A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without **hindsight reconstruction** of the invention from the prior art. In making this evaluation, all facts must be considered. The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or **hindsight reconstruction** to supply deficiencies in its factual basis. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968) (emphases in original).

Additionally, MPEP §2143.01 (III) reads:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). MPEP 2143.01.

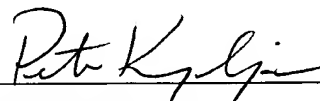
The hindsight reconstruction engaged in by the Office Action is impermissible since nothing in the prior art or the references suggests the desirability of combining the Ogawa, Kamiyama, and Melen references. Additionally, even though hindsight reconstruction has been engaged in, the Office Action still has not produced a reference or combination of references that teach each and every element of the claimed invention. For this additional reason all claims are non-obvious and should be allowed.

Conclusion

For the reasons set forth above, **claims 1-10, 12-19 and 21-23** patentably and unobviously distinguish over the references of record and are now in condition for allowance. An early allowance of all claims is earnestly solicited.

Respectfully submitted,

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